



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,249	03/13/2001	Masaaki Mori	1095.1171/JDH	9135

21171 7590 11/01/2006

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

BARQADLE, YASIN M

ART UNIT PAPER NUMBER

2153

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/804,249	MORI ET AL.	
	Examiner	Art Unit	
	Yasin M. Barqadle	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10,11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10,11 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/30/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 26, 2006 has been entered.

Response to Amendment

2. The amendment filed on June 26, 2006 has been fully considered but are not deemed persuasive.

- Claims 1,3-8, 10, 11 and 13 are amended.
- Claims 9 and 12 are cancelled.
- Claims 1,3-8, 10, 11 and 13 are presented for examination.

Response to Arguments

Applicant argues that “none of the foregoing references, individually or combined, disclose the applicants ‘attached file retrieving means’ nor the Applicants ‘attached file transferring means’ as recited in claim 1, for example.” Examiner notes that Arnold teaches “technical advantage is that the invention manages access to a remotely located attachment through use of an attachment access list. Only those individuals or entities named on the access list may have access to the attachment. Preferably only the recipients of the e-mail message are listed on the access list.”

Art Unit: 2153

(Arnold, col. 2, lines 56- 61). Hence Arnold teaches accessing (retrieving) email attachments to read, view or edit col. 3, line 3-8). Arnold also teaches locating attachments in a remote web site col. 4, lines 6-24).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1,56,7,10 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "... attached file retrieving means to a predetermined server using a second user account and a second password ... adding the second user account and the second password to the electronic mail". The specification does not specify using a second user account and a second password. It does not clearly show how the second user account and second password is used to login by a second user.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 2153

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1,5-8, 10, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (U.S. Patent Number 6,275,848, hereinafter "Arnold") in view of Tanaka et al (U.S. Patent Number 5,905,495, hereinafter "Tanaka". Arnold discloses method and apparatus for automated referencing of electronic information.

In referring to claims 1, 5, 6, 7, 10, and 13, Arnold shows substantial features of the claimed invention, including:

Attached file separating step/means for separating, in the case of an attached file being added to electronic mail sent from the sender, the attached file from the electronic mail: Arnold, Figure 2, element 210 shows the step of detaching the attachment from the mail item (which inherently implies an attached file separating means)

Attached file retrieving means for retrieving, in the cases of a first store location information, a first user account, and a first user password being added to electronic mail sent from the sender, an attached file from a server of location shown by the first store location information using the first user account and the first password (Arnold, Figure 2, element 214 shows the step of submitting the attachment with a pointer (which inherently implies a store location information adding means);

attached file transferring means for transferring the attached file separated from the electronic mail by the attached file separating means or retrieved from the server by the attached file retrieving means to a predetermined server using a user (second) account and password (second): Arnold, Figure 2, element 212 shows the step of storing the attachment on a remote site

Art Unit: 2153

(which inherently implies an attached file transferring means (Access to the remotely-located attachment is controlled by an access list or other similar means for defining access rights.

Preferably, only those recipients of the e-mail message have access to the Web site, and no other party has access rights to the attachment col. 3, lines 62-66))

Store location information adding means for adding second store location information indicating a location where the attached file transferred by the attached file transferring means is stored to the electronic mail: Arnold, Figure 2, element 214 shows the step of submitting the attachment with a pointer (which inherently implies a store location information adding means)

However, Arnold does not show adding a user account (second user account) and password (second password) to an electronic mail.

Nonetheless this feature is well known in the art and would have been an obvious modification of the system disclosed by Arnold as evidenced by Tanaka. In analogous art Tanaka discloses a communication system using electronic mail. Tanaka shows adding a user account and password to an outgoing electronic file (Fig. 13 and 16). Given these teachings a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Arnold so as to use both the password and the user ID for identification and a certification information (col. 37, lines 56-64). Tanaka further shows using a user account and password (figs 13 and fig. 16. Tanaka also discloses an outgoing file as an electronic mail addressed to a plurality of users with one or more user IDs col. 29, lines 64 to col. 30 line 15)

Arnold further shows a store location information corresponds to a store server, a store directory, a login account and a password to allow a receiver of the electronic mail to retrieve the attachment: "Another technical advantage is that the invention manages access to a remotely

Art Unit: 2153

located attachment through use of an attachment access list. Only those individuals or entities named on the access list may have access to the attachment. Preferably only the recipients of the e-mail message are listed on the access list.” (Arnold, col. 2, lines 56- 61)

In referring to claim 3, Arnold in view of Tanaka shows,

Not only store location information but also transfer method information indicating a transfer method used by the attached file transferring means are added to the electronic mail:

“...(5) placing the attachment on a remote site; and (6) inserting a pointer into the message, wherein the pointer is linked to the remote site. “(Arnold, col. 2, lines 36-38) A system that appends a pointer, which allows the user to retrieve the e-mail attachment, inherently implies the pointer includes the transfer method for retrieving said file

In referring to claim 4, Arnold in view of Tanaka shows,

The attached file separating means, attached file transferring means, and store location information adding means are implemented as exit programs on an electronic mail server:

Arnold, Figure 2 shows the attached file separating means, attached file transferring means, and store location information adding means are implemented as exit programs on an electronic mail server.

In referring to claims 8 and 11, although Arnold in view of Tanaka shows substantial features of the claimed invention, Arnold in view of Tanaka does not explicitly show how the server is chosen. Arnold in view of Tanaka does not explicitly show choosing' a server based on the

Art Unit: 2153

header of the electronic mail. Nonetheless this feature is well known in the art and would have been an obvious modification to the system disclosed by Arnold in view of Tanaka. A person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Arnold in view of Tanaka so as to choose the same server every time a specific recipient is to receive an email in order to consolidate all of a recipient's attachments and facilitate easier access to them.

Conclusion

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained form the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR system. Status information for

Art Unit: 2153

unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YB

Art Unit 2153


ABDULHADI SALEH
PRIMARY EXAMINER